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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,368	03/07/2000	Tetsuro Motoyama	5244-0114-2	9637

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/520,368

Applicant(s)

MOTOYAMA ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1-30 are pending in this application.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 11, 12, 21, and 22, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, and 19-26 of U.S. Patent No. 5,819,110, hereafter "110". Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims system, method and software product for monitoring a device by another device and transferring a desired device driver from one device to the other when needed using direct connection and email message, which are also claimed by "110" in claims 1-4, and 19-26.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-6, 11-16, and 21-26 are rejected under 35 U.S.C. 102( b) as being anticipated by Motoyama (US 5,819,110 ).

6. Motoyama is cited by the applicant in IDS No. 4 filed 9/13/2002.

7. As to claims 1 and 11, Motoyama discloses the invention as claimed including a method and a system, the method comprising monitoring a first device by a second device (Figs. 10 and 11; and col. 9, lines 16-18, 51-52); determining, by the second device, whether a current device driver in the first device is a desired device driver (inherent in col. 9, lines 35-38, 43-46); and first transferring the desired device driver from the second device to the first device (col. 9, lines 43-47) when it is determined that the current device driver in the first device is different from the desired device driver (inherent in col. 9, lines 43-46), wherein the current device driver and the desired device driver are configured to control operations of the first device (inherent in col. 9, lines 44-46).

8. It is inherent in Motoyama's disclosure (col. 9, lines 35-50) that the new control software (desired device driver) is downloaded (transferred) from the second device (the remote device for controlling, diagnosing, and monitoring) to the first device (the business office machine) after the determination by the second device (the remote device for controlling, diagnosing, and monitoring) that a current device driver is not a desired device driver ( a current control software of the business office machine includes a bug). It is inherent that the current device driver (bugged control software) and the desired device driver (new control software) are configured to control operations of the first device.

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9. As to claim 21, the claim is rejected for the same reasons as claims 1 and 11 above. In addition, Motoyama discloses a program product including a computer readable medium embodying program instructions for causing a system to perform the claimed method steps (col. 13, lines 13-16).

10. As to claims 2, 12, and 22, the claims are rejected for the same reasons as claims 1, 11, and 21 above. In addition, Motoyama discloses first transferring the desired device driver from the second device to the first device using at least one of a direct connection message, a network mail message and an electronic mail message (col. 9, lines 35-50; and col. 2, lines 6-27).

11. As to claims 3, 13, and 23, Motoyama discloses the first device is connected to a first network and the second device is connected to a second network (network 16, and network 52, Fig. 1).

12. As to claims 4, 14, and 24, Motoyama discloses the first and second networks are connected by a third network (Internet 10, network 16, and network 52, Fig. 1).

13. As to claims 5, 15, and 25, the claims are rejected for the same reasons as claims 1, 11, and 21 above. In addition, it is inherent in Motoyama's disclosure that transferring the desired device driver includes transferring information regarding the desired device driver.

14. As to claims 6, 16, and 26, the claims are rejected for the same reasons as claims 1, 11, 21, and 5, 15, 25 above. In addition, it is inherent in Motoyama's disclosure that transferring the

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desired device driver includes transferring information regarding the desired device driver. This information may include the version of the device driver, the effective date of the desired device driver, and an indication of an operating system for the desired device driver.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1, 11, and 21 are further rejected under 35 U.S.C. 102(e) as being anticipated by Sandler et al. (US 6,378,069), hereafter "Sandler".

17. As to claims 1 and 11, Sandler discloses the invention as claimed including a method and a system, the method comprising monitoring a first device (subscriber unit) by a second device (software download server) (col. 3, lines 5-6); determining, by the second device, whether a current device driver in the first device is a desired device driver (inherent in col. 3, lines 5-6); and first transferring the desired device driver from the second device to the first device (col. 3, lines 7-13) when it is determined that the current device driver in the first device is different from the desired device driver (inherent in col. 3, lines 5-6), wherein the current device driver and the desired device driver are configured to control operations of the first device (inherent).

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18. As to claim 21, the claim is rejected for the same reasons as claims 1 and 11 above. In addition, it is inherent in Sandler's disclosure that a program product including a computer readable medium embodying program instructions is causing the claimed system to perform the claimed method steps.

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 7-10, 17-20, and 27-30 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Sandler et al. (US 6,378,069), hereafter "Sandler" in view of Shepherd et al. (US 6,560,643), hereafter "Shepherd".

21. As to claims 9 and 19, Sandler discloses the invention substantially as claimed including a method and a system, the method comprising determining whether a user of a first device (subscriber unit) desires a desired device driver (up-to-date version of software) of a second device (software download server) to be transferred to the first device (col. 7, lines 55-60) when the user of the first device accesses the second device (inherent in col. 7, lines 52-60); and transferring the desired device driver (up-to-date version of software) from the second device (software download server) to the first device (subscriber unit) when it is determined that the user of the first device desires the desired device driver of the second device to be transferred to the first device.

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22. Sandler does not specifically disclose the desired device driver is configured to control operations of the second device. Shepherd, on the other hand, discloses transmitting a software package from one terminal controlled by the software package to another terminal to be controlled by the software package, that is the desired device driver (software package to modify the manner in which the terminal operate) is configured to control operations of the second device (col. 1, lines 26-31, 38-41). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Sandler and Shepherd because Shepherd method of transmitting the desired driver from a device to another would reduce undue delay in Sandler's system, specially when driver sources are widely separated and interconnected over long distances and hence lengthy times may be involved in the transfer (see, Shepherd, col. 1, lines 20-25).

23. As to claim 29, the claim is rejected for the same reasons as claims 9 and 19 above. In addition, it is inherent in Sandler and Shepherd disclosures that a program product including, a computer readable medium embodying program instructions is causing the claimed system to perform the claimed method steps.

24. As to claims 7, 8, 17, 18, 27, and 28, the claims are rejected for the same reasons as claims 9, 19, and 29 above. In addition, Shepherd discloses second transferring the desired device driver from the first device to a third device (col. 1, lines 26-31, 38-41).

25. As to claims 10, 20, and 30, the claims are rejected for the same reasons as claims 9, 19, and 29 above. In addition, Sandler (inherent in col. 4, lines 10-17) and Shepherd (inherent in col. 2, lines 23-34) disclose first transferring the desired device driver from the second device to



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the first device using at least one of a direct connection message, a network mail message and an electronic mail message.

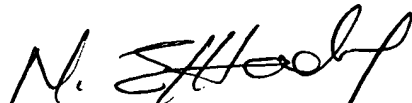
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakagiti (US 6,606,669); Gase et al. (US 5,580,177) ; Collins, III et al. (US 6,286,041) ; Takahashi et al. (US 6,195,432); Roberts et al. (US 5,960,167) ; Keyes et al. (US 6,516,427); Lounsberry et al. (US 6,325,540); Tomlinson, Jr. et al. (US 6,411,578) ; Campbell et al. (US 5,768,495) ; Gandel et al. (US 6,167,568); Wooddruff (US 2001/0054161); and Lawrence et al. (US 2003/0137688).

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Nabil El-Hady, Ph.D., M.B.A.  
Primary Patent Examiner  
September 3, 2003